

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 3-6, 9, 10, 15-18, 21-23, 26-29, and 32-46 are pending in the application, with claims 3, 4, 15, 16, 23, 26, 27, and 42 being the independent claims. Claims 3, 4, 6, 9, 10, 26, 27, 29, 32, 33, 35-37, and 44-46 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections Under 35 U.S.C. § 102

The Office Action rejected claims 3-6, 9, 10, 15-18, 21-23, 26-29, and 32-46 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0229638 to Carpenter *et al.* (hereinafter "the Carpenter Publication"). (See Office Action at p. 4.) Applicants respectfully traverse these rejections.

At page two of the Office Action, the Examiner contends that:

Applicant's arguments with regards to Carpenter *et al.* (U.S. 2003/0229638) and the Carpenter *et al.* provisional (60/180368) have been fully considered, but they are not persuasive. In the remarks, applicant argues that the provisional application 60/180368 from which U.S. 2003/0229638 claims priority does not disclose the features of calculating a ratio and incrementing a counter.

In response to this argument, Examiner respectfully disagrees. A non-provisional application is afforded the priority date of the provisional application so long as there is adequate written description to support that the inventors did in fact have possession of the invention described in the non-

provisional application at the time of filing the provisional. The support found in the provision does not have to be verbatim as long as one reasonably feels that the inventor had possession of the invention at time of filing. Thus, the non-provisional application is itself proper prior art, unless it can be proven that the disclosure is not fully supported by the provisional.

Applicants respectfully dispute this characterization of the criteria under which a nonprovisional patent application can claim the benefit of a provisional patent application.

Section 201.11(I)(A) of the Manual of Patent Examining Procedure states (emphasis added):

Under 35 U.S.C. 119(e), the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter claimed in the nonprovisional application that claims the benefit of the provisional application. In *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisional application to be afforded the priority date of the provisional application, "the specification of the provisional must 'contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. § 112 ¶1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application."

In *New Railhead*, the patented drill bit was the subject of a commercial offer for sale. A provisional application was filed after the sale offer, but well within the one year grace period of 35 U.S.C. 102(b). A nonprovisional application, which issued as Patent No. 5,899,283, was filed within one year of the filing of the provisional application but more than one year after the sale offer. If the '283 patent was not afforded the priority date of the provisional application, the patent would be invalid under 35 U.S.C. 102(b) since it was filed more than one year after the commercial offer for sale. *The court looked at claim 1 of the '283 patent which recites a bit body being angled with respect to the sonde housing. The court then reviewed the provisional application and concluded that nowhere in the provisional application is the bit body expressly described as "being angled with respect to the sonde housing" as recited in claim 1 of the '283 patent. The court held that the disclosure of the provisional application does not adequately support the invention claimed in the '283 patent as to the angle limitation and therefore, the '283 patent is not entitled to the filing date of the provisional application under 35 U.S.C. 119(e)(1) and the '283 patent is invalid under 35 U.S.C. 102(b).*

Thus, a nonprovisional patent application cannot claim the benefit of a provisional patent application merely if the provisional patent application has an adequate written description to

support that the inventors did in fact have possession, at the time of filing the provisional patent application, of the invention described in the specification of the non-provisional patent application. In order for a nonprovisional patent application to claim the benefit of a provisional patent application, the provisional patent application must contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms, 35 U.S.C. § 112 ¶ 1, to enable an ordinarily skilled artisan to practice the invention *claimed* in the nonprovisional patent application.

Regarding the feature of calculating a ratio of resumes associated with a matched employment market category to job listings associated with the matched employment market category, the Examiner, at page three of the Office Action, contends that:

Looking to the provisional for support that the inventor had possession of the invention at the time of filing, the provisional application of Carpenter et al. discusses such storing documents and making them searchable (See at least pages), as well as returning a proportion of the entire pool of resumes (See at least pages 2, 4, 7-9, which discloses the concept based searching technology. See pages 12, 16, 19, where search results that are gained that are a portion of the entire pool).

Even if, *arguendo*, U.S. Provisional Patent Application No. 60/180,368 (hereinafter "the Carpenter Provisional") discusses storing documents and making them searchable as well as returning a proportion of the entire pool of resumes, this is not equivalent to calculating a ratio of resumes associated with a matched employment market category to job listings associated with the matched employment market category, which is a feature included in each of independent claims 3, 15, 23, and 26 of the subject patent application. Because the second paragraph of 35 U.S.C. § 112 provides that (emphasis added) "[t]he specification shall conclude with one or more claims *particularly pointing out* and distinctly claiming *the subject matter which the applicant regards as his invention*" and because the Carpenter

Provisional does not disclose, teach, or suggest calculating a ratio of resumes associated with a matched employment market category to job listings associated with the matched employment market category, the Carpenter Provisional does not anticipate any of independent claims 3, 15, 23, and 26. Because each of claims 5, 6, 9, 10, 17, 18, 28, 29, 32, 33 depends upon claims 3, 15, or 26 and because of the additional distinctive features of each of claims 5, 6, 9, 10, 17, 18, 28, 29, 32, 33, each of these claims is also not anticipated by the Carpenter Provisional.

Regarding the features of incrementing a first counter associated with a matched employment market category when an employment resource is a resume and incrementing a second counter associated with the matched employment market category when the employment resource is a job listing, the Examiner, at page four of the Office Action, contends that:

Looking to the provisional for support that the inventor had possession of the invention at the time of filing, the provisional application of Carpenter et al. discusses spider technology and counting documents. See pages 8-9, 11-12, which discloses spider tools, real time indexes, and data collection.

Even if, *arguendo*, the Carpenter Provisional discusses spider technology and counting documents as well as spider tools, real time indexes, and data collection, this is not equivalent to incrementing *a first counter* associated with a matched employment market category when an employment resource is *a resume and* incrementing *a second counter* associated with the matched employment market category when the employment resource is *a job listing*, which are features included in each of independent claims 4, 16, 27, and 42 of the subject patent application. Again, because the second paragraph of 35 U.S.C. § 112 provides that (emphasis added) "[t]he specification shall conclude with one or more claims *particularly pointing out* and distinctly claiming *the subject matter which the applicant regards as his invention*" and

because the Carpenter Provisional does not disclose, teach, or suggest incrementing a first counter associated with a matched employment market category when an employment resource is a resume and incrementing a second counter associated with the matched employment market category when the employment resource is a job listing, the Carpenter Provisional does not anticipate any of independent claims 4, 16, 27, and 42. Because each of claims 34-41 and 43-46 depends upon claims 4, 16, or 27 and because of the additional distinctive features of each of claims 34-41 and 43-46, each of these claims is also not anticipated by the Carpenter Provisional.

Accordingly, Applicants respectfully request that the Examiner reconsider and remove her rejections of claims 3-6, 9, 10, 15-18, 21-23, 26-29, and 32-46 under 35 U.S.C. § 102(e) and pass these claims to allowance.

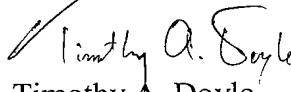
Conclusion

All of the stated grounds of rejection have been properly traversed. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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Date: 5 MAY 08

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